I. Claims 1-16, 35-37 drawn to a method for microdissecting tissue, classified in class 435, subclass 40.5.

II. Claims 17-22, 35-37 drawn to a method of performing tissue microdissection of a tissue specimen, classified in class 435, subclass 7.1.

III. Claim 24-34, 35-37 drawn to a method for fluorescently staining a tissue section for microdissection, classified in class 435, subclass 40.52.

Groups I-III Should Be Examined Together

Applicants submit that the subject matter of Groups I-III are not unrelated inventions, but are a single invention or closely related inventions because they each utilize the same method for fluorescently labeling tissue. Each claim in the application recites the method of claim 35 for fluorescently labeling tissue that preserves biological molecules. Thus, the subject matter of all such claims is interrelated. Hence, Groups I-III are in actuality drawn to or based on a linked invention, which acts to prevent restriction between those inventions (MPEP § 809.03). The Examiner implicitly recognizes such linkage by including claim 35 in each of Groups I-III. Thus, Groups I-III should not be subject to restriction and should be examined together.

Applicants further submit that it would not be unduly burdensome for the Examiner to search for prior art relating to the inventions of Groups I-III because the claims of each such group contain a common limitation, *i.e.*, the same method for fluorescently labeling tissue as recited in claim 35.

At Least Groups I and II Should be Examined Together

Even if the Examiner is not persuaded that all of Groups I-III should be examined together, Applicants submit that the claims of Groups I and II are "different definitions of the same disclosed subject matter, varying in breadth or scope of definition" (MPEP §806.03). Therefore, restriction between Groups I and II is improper.

The Examiner states that Groups I and II are independent and distinct inventions because Group I claims are "drawn to a method for microdissecting tissue," and Group II claims are "drawn to a method of performing tissue microdissection." These descriptive phrases are

analogous. To emphasize this point, claim 17 of Group III (and, therefore, all of its dependent claims) has been amended herein to recite "[a] method for microdissecting a tissue specimen."

In addition to both being drawn to methods for microdissecting a tissue specimen, independent claims 1 (Group I) and 17 (Group III) and their respective dependent claims vary only in breath or scope of definition of the steps in the respective methods. For example, claim 1 recites, in part, "labeling a sample of the tissue according to the method of claim 35 . . . ," while claim 17 recites, in part, "exposing the tissue specimen to a fluorescent specific binding agent according to the method of claim 35, wherein the fluorescent specific binding agent is a fluorescently labeled antibody, and wherein the fluorescently labeled antibody specifically binds to a component of interest in the tissue; washing unbound antibody from the tissue . . . ." The above-exemplified steps in both claims define the labeling of a tissue specimen but such definitions differ in breath and scope. The same is true for each remaining step of the claims. Thus, restriction between Groups I and III is improper.

CONCLUSION

It is respectfully submitted that the present application is in condition for substantive examination. If it may further prosecution, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446

By _____
Tanya M. Harding, Ph.D.
Registration No. 42,630

Marked-up Version of Amended Claims
Pursuant to 37 C.F.R. §§ 1.121(b)-(c)

17. A method ~~of performing tissue microdissection of~~for microdissecting a tissue specimen, comprising:

exposing the tissue specimen to a fluorescent specific binding agent according to the method of claim 35, wherein the fluorescent specific binding agent is a fluorescently labeled antibody, and wherein the fluorescently labeled antibody specifically binds to a component of interest in the tissue;

washing unbound antibody from the tissue;

intensifying an image of the tissue specimen which has been exposed to the fluorescently labeled antibody, to obtain an intensified fluorescent signal from the tissue;

applying a transfer member to the tissue;

directing a target laser beam to the component of interest in the tissue, to mark the component that is to be dissected from the tissue specimen, while viewing the target laser beam through an infrared filter that selectively filters infrared radiation but not the fluorescent signal, to minimize heat distortion of the intensified image, while still viewing the intensified signal; and

applying radiant laser energy to the component of interest to transfer the component to the transfer member.